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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,164	11/09/1999	BENJAMIN EITHAN REUBINOFF	13164	6220

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EXAMINER

WOITACH, JOSEPH T

ART UNIT PAPER NUMBER

1632

DATE MAILED: 07/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

File

Advisory Action

Application No.

09/436,164

Applicant(s)

Reubinoff, B. E.

Examiner

Joseph T. Weitach

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --THE REPLY FILED Jul 22, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Arguments are directed to limitations which have not been entered.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 19-26 and 37-44
- Claim(s) withdrawn from consideration: 1-18, 29-36, 45, and 46
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): _____
10. ☐ Other: _____

Deborah Crouch
DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 18061630

Art Unit: 1632

Section 2(a) and (c):

The proposed amendment changing “inducing” to “directing” raises new issues for new matter and rejections made under 35 USC 112, first and second paragraphs. The amendment does not indicate where support for the proposed amendment can be found, and upon review of the present specification, Examiner can not find literal support for this amendment.

Additionally, it is noted that the final step of the method recites that the cells are cultured 'under conditions that induce' not to direct any form of differentiation, which raises issues under 35 USC 112, second paragraph, to what is encompassed by inducing and/or directing, since this is the only change made to the claims. Absent critical steps which lacking from the present claims, it would appear that practicing the recited steps that both inducing and directing would be accomplished. Further, methods drawn to specifically “directing” or specifically controlling the differentiation and fate of a cell to a particular cell type would raise new issues of enablement under 35 USC 112, first paragraph.